



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,155	04/24/2001	Shogo Hyakutake	202319US2X	3275

22850 7590 07/22/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,155

Applicant(s)

HYAKUTAKE ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-27 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-27 and 29-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8, 10-27 and 29-41 are presented for examination. Claims 9 and 28 have been canceled.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.
3. It is noted that claim 19, line 3 contains a typo wherein "claim 1-18" should be amended as "claims 1-8 and 10-18" because claim 9 has been canceled.

Claim Rejections - 35 USC § 102

4. Claims 1-5, 7-8, 14-15, 18-24, 26-27, 33-34, 37-38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Grasso et al.[U.S. PGPub. 20040254911].
5. As to claim 1, Grasso teaches the invention as claimed including: a method of storing document information in an application service provider (ASP) [210, Fig.3] which is connected to a user terminal [130, Fig. 3] through a network, comprising the steps of:
 - inputting said document information into said user terminal [e.g.,122, Fig.3];
 - inputting a previously created e-mail address into said user terminal, said e-mail address being confirmed by said ASP and corresponding to a storage location in a document database of

said ASP [e.g., paragraphs 7, 24 and 34; note that the email address obtained from the ASP must have been confirmed at the time of registration] and sending said document information to said e-mail address via said network so that the ASP can store the document information at said storage location in the document database [e.g., paragraphs 9, 20 and 23].

6. As to claims 2-5, Grasso FTT said step of inputting the document information comprises manually inputting said document information into said user terminal, said the step of manually inputting said document information comprises one of scanning and downloading said document information into said user terminal, wherein said document information is stored to a memory in said user terminal [e.g., 110, 122, Fig.3; i.e., user manually inserts document into scanner, followed by automatic scanning of the document into the scanner].

7. As to claims 7-8, Grasso FTT said step of inputting an e-mail address into said user terminal comprises typing said e-mail address into an alphanumeric keypad on said user terminal [i.e., by default this is an optional method of sending inputting the e-mail address], wherein said step of sending said document information to said e-mail address comprises sending the document information via the Internet [150, Fig.3]

8. As to claims 14-15, Grasso teaches sending said document information to said e-mail address comprises sending said document information to said e-mail address concurrently with sending said document information to said user contact device via one of a public phone line and the Internet [paragraph 58].

9. As to claims 18-24, 26-27, 33-34, 37-38 and 40, since the features of these claims can also be found in claims 1-5, 7-8 and 14-15, they are rejected for the same reasons set forth in the rejection of claims 1-5, 7-8 and 14-15 above.

Claim Rejections - 35 USC § 103

10. Claims 6 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al.(hereafter "Grasso") [U.S. PGPub. 20040254911], as applied to claims 1-5, 7-8, 14-15, 18-24, 26-27, 33-34, 37-38 and 40 above, further in view of official Notice .

11. As to claim 6, Grasso DNST that said step of inputting a previously created e-mail address into said user terminal comprises storing said e-mail address in a memory of said user terminal and associating said stored e-mail address with a quick send key on a keypad of said user terminal and inputting said e-mail address in response to a selection of said quick send key.

However, official Notice is taken that it is well known in the art that when sending email via an Internet Service Provider (ISP), the subscriber's PC is normally provided with a email agent for storing email address book in a local memory and a selected email address can be quickly entered into the "send to" or "copy to" fields by activating a quick send key (which may also be a predefined key on the alphanumeric keypad).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such a quick send key for sending Grasso's email because the method is known to be convenient and could also prevent typos.

12. As to claim 25, since the features of this claim can also be found in claims 1, 6 and 20, it is rejected for the same reasons set forth in the rejection of claims 1, 6 and 20 above.

13. Claims 10-13, 16-17, 29-32, 35-36, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al.(hereafter "Grasso") [U.S. PGPub. 20040254911], as applied to claims 1-8, 14-15, 18-27, 33-34, 37-38 and 40 above.

14. As to claims 10-13, Grasso teaches the invention substantially as described in claim 1. Grasso does not specifically teach creating a storage folder for storing documents to said ASP.

However, official Notice is taken that storing data in various storage folder created by a user is well known in the art. For example, an Internet Service Provider (ISP) may offer each subscriber certain storage space for storing personal web pages, wherein a file manager is available for creating various subfolders for storing designated document types.

Since Grasso's ASP server needs to handle different subscribers' data and each subscriber may transfer different types of data or image into the server, it is obvious to one of ordinary skill in the art to have used the well known file manager to create different folders for different subscribers, and various subfolders under each subscriber's folder to record different type of document information, because this is a nominal approach for organizing large volume of data.

Grasso further teaches that users may register with an Internet web site of the knowledge management service provider by registering one or several of their own printers (facsimile

machines, scanners or multi-function devices) with the service provider, specifying their network address and preferred print protocol. The Internet knowledge management web site provides the customer with the augmented recording queues corresponding to the registered devices [paragraphs 24].

Grasso DNST that each different type of data (i.e., data produced from facsimile machines, scanners, etc) is being placed in different folders, each associated with a folder email address and a backup email address for storing the particular type of document.

However, it is well known that storing different types of data in different folders is a well-known practice of organizing stored document. WOB to organize Grasso's document storage with different folders by further associating Grasso's recording queues in a folder of its data type because different data type requires different post processing for retrieving information about the content of the documents, and by sending the data to a different storage folder (via a respective email address and/or backup email address for a respective mirror site) would facilitate the process of archiving the data.

15. As to claims 16-17, 29-32, 35-36, 39 and 41, since the features of these claims can also be found in claims 1-15, 18-24, 26-28, 33-34, 37-38 and 40, they are rejected for the same reasons set forth in the rejection of claims 1-15, 18-24, 26-28, 33-34, 37-38 and 40 above.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Prust [U.S. Pat. No. 6714968].

17. Applicant's arguments with respect to claims 1-42 on 4/26/2005 have been considered but are moot in view of the new ground(s) of rejection.

18. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

July 20, 2005

Wen Tai Lin
7/20/05